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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **IDEI, et al.**

Group Art Unit: 1774

Serial No.: 09/508,617

Examiner: **Lawrence D. Ferguson**

Filed: **March 14, 2000**

P.T.O. Confirmation No.: 8477

For: **PAPER FOR INK JET AND ELECTROPHOTOGRAPHIC RECORDING**

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 21, 2006

Sir:

In response to the Office Action dated **May 12, 2006**, Applicants respectfully request reconsideration of the 35 U.S.C. § 102(b) rejection of claims 1 and 5-7 as anticipated by **Fujioka et al.** (previously applied).

As noted in the response filed April 17, 2006, claim 1 of the present application recites that the cationic resin is present on the surface of the support, and the recording paper has a surface resistivity of $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$.

In contrast, the final product disclosed in **Fujioka et al.**, which is to be compared with the present invention, is constituted of a paper substrate, an electroconductive layer and a record forming layer formed on the electroconductive layer. In **Fujioka et al.**, a cationic resin is contained only in the electroconductive layer, and the record forming layer is mainly composed of an insulative resin. A cationic resin is not present on the surface of the recording layer. Moreover, **Fujioka et al.** fails to disclose or suggest that the surface resistivity of the recording side of the paper is $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$, as claimed in the present invention. There is no

motivation in Fujioka et al. to lead one of ordinary skill in the art to the present invention with the other respects.

In the Office Action, the Examiner has indicated:

Applicant argues that the coating applied to the base sheet does not comprise cationic resin on the recording side of the paper. In claims 1 and 5, the limitation of "on the recording side of the paper" has been cancelled from the claim. Examiner maintains Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins, (column 5, lines 33-44). Applicant further argues Fujioka fails to disclose a surface resistivity of the recording side of the paper is 1.0×10^9 to 9.9×10^{13} ohms. Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins having a surface resistivity of 10^6 to 10^{10} ohms (column 5, lines 36-42).

In response to this argument, it should be noted that claim 1 recites that a cationic resin is present on a surface of the support, which does not limit the presence of the resin to only the surface of the recording side, but permits the cationic resin to be present on both surfaces. In Fujioka et al., the cationic resin is not present on either surface of the paper.

Thus, the 35 U.S.C. § 102(b) rejection should be withdrawn.

Applicants respectfully request reconsideration of the 35 U.S.C. § 103(a) rejection of claims 3 and 4 as unpatentable over Fujioka et al. in view of Shepherd (previously applied).

Shepherd has been cited for teaching paper sizing materials consisting of rosin (column 1, lines 18-20) and alkenyl succinic anhydride sizing agents (column 2, lines 45-63).

Shepherd, like Fujioka et al., fails to teach, mention or suggest the cationic resin being present on a surface of the paper, which may include the recording side.

Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Applicants respectfully request reconsideration of the 35 U.S.C. § 102(b) rejection of claim 1 as anticipated by U.S. Patent 6,335,085 to Asano et al. (hereafter, "Asano et al.").

Asano et al. discloses an ink jet recording sheet including a substrate sheet impregnated or coated with a cationic compound; an ink-receiving layer formed on the cationic compound-applied substrate sheet and containing a pigment and a binder and a gloss layer formed on the ink receiving layer and containing a polymer resin produced from ethylenically unsaturated monomers.

The Examiner has urged that, although the surface resistivity and cation equivalent are not disclosed in Asano et al., they are inherent features because the cationic material is disclosed to be applied in a dry adhering amount of 0.1 to 10 g/m², which is a range which encompasses that which is recited in claim 1 of the instant application. However, because the range of 0.5 to 2.0 g/m² recited in claim 1 is narrower than that disclosed in Asano et al., the surface resistivity limitation of claim 1 might not be met when the dry adhering amount is outside the range recited in claim 1, even though it may be within the range disclosed in Asano et al. Thus, the surface resistivity and cation equivalent limitations recited in claim 1 are not inherently taught by Asano et al.

Thus, the 35 U.S.C. § 102(b) rejection should be withdrawn.

In view of the aforementioned remarks, claims 1 and 3-7 are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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